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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,216	01/02/2004	Philip S. Siegel	067439.0157	1168

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EXAMINER

FISCHETTI, JOSEPH A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/751,216

Applicant(s)

SIEGEL, PHILIP S.

Examiner

Joseph A. Fischetti

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Specification***

Applicant is asked to insert the missing data missing on page 1 of the specification.

***Double Patenting***

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/817,353 in view of Roman et al and Haseltine '143. Roman et al. and Haseltine disclose obvious variants of the elements recited in claims 1-16

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6,10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Roman et al.

Roman et al. disclose a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, a request to initiate return processing (customer clicks on RETURN), via a web access tool associated with the customer (access tool is read as the

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computer on which the consumer is using and hence it is associated with him); displaying to the customer, here the consumer, return information at the web access tool (pp0019 "the system provides instructions for return shipping); receiving return-related data from the customer, via the web access tool (pp0015 clickreturns.com receives information from customer regarding receipt number etc.), thereby identifying a return item; and generating data for printing a return label ( pp0020 consumer prints a packing slip). Regarding the limitations of a list of one transaction and return related data being elected from the list, applicant is directed to Roman et al. paragraph 0017 which explicitly states the display offers replacement or exchange. This display of two options for returns is read as a list. WEBSTER'S COLLEGIATE DICTIONARY TENTH EDITION defines a list, *inter alia*, as:

3. *n* the total number to be considered or included; *v.* ENUMERATE

Clearly the display in Roma et al. lists the options of "replacement or exchange" and the user responds by choosing one of these as the selection from the list.

Claim 2, wherein the displaying step is performed by displaying a return information web page ( page of click return.com is read as a web page).

Claim 3,4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64

Claim 5: accessing a database to obtain customer information about the customer (see pp 0016 line 3), and wherein the displaying step includes displaying at least part of the customer information (the offered replacement product is read as part of customer information since it will reference the initial product).

Claim 6: accessing a database to obtain customer transaction information (see pp0016 line 3), and wherein the displaying step includes displaying at least part of the transaction information (the offered replacement product is read as transaction information since it will reference the initial purchased product).

Re claim 10/11: performed prior to the downloading step, of determining whether the return is valid (see pp 0016 line 2 submitted return is analyzed for fraud against a database). Official notice is taken regarding the giving of notice that the request has been rejected. See e.g. US6192347 par. 517

Claim 12: see pp 0016 e-tailer establish parameter e.g. rules to determining whether the return is valid.

Claims: 13/14/16: a merchant is notified of the return item (information about the customer is that he is returning the product undamaged) by the processing center pp0022 line 8).

Claim 15: pp0020 consumer prints a packing slip which obviously includes the step of downloading the data for printing a return label to the web access tool.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7,8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Roman et al. in view of Haseltine '143. Roman et al. appears to be silent regarding a database dedicated to merchant return rules. However, Haseltine does disclose merchant specific rules for returning products which are in a database tied to the packing slip identifier. It would be obvious to modify the method of Roman et al. to include the merchant specific return rules, the motivation being the ability to accommodate different business practices.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's arguments filed 11/9/05 have been fully considered but they are not persuasive. Applicant argues no disclosure in the art of displaying from a list return information. The examiner reads Roman et al. differently. Roman et al. paragraph 0017 explicitly states the display offers replacement or exchange choices. This display of two

options for returns is read as a list. WEBSTER'S COLLEGIATE DICTIONARY TENTH EDITION defines a list, *inter alia*, as:

3. *n* the total number to be considered or included; *v.* ENUMERATE

Clearly the display in *Roma et al.* lists the options of "replacement or exchange" and the user responds by choosing one of these as the selection from the list.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

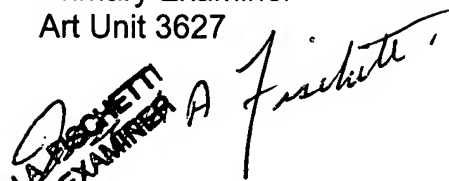
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (571) 272-6780.

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Joseph A. Fischetti  
Primary Examiner  
Art Unit 3627

  
**JOSEPH A. FISCHETTI**  
**PRIMARY EXAMINER**